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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/204,888	12/03/1998	CHARLES A. ELDERING	8887.3002	9427

27832 7590 03/13/2003

EXPANSE NETWORKS, INC.
300 NORTH BROADSTREET
DOYLESTOWN, PA 18901

EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/204,888	ELDERING ET AL.	
	Examiner Christopher Grant	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 December 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 78-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 78-101 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 78-101 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19, 23 and 5 of U.S. Patent No. 09/204,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example, note the following relationship between the current application claim 78 and patented claim 19:

- a) the claimed "*A method for generating a subscriber profile...*" (lines 1-2) of the current application claim 78 corresponds to the "*A method for generating a subscriber profile...*" (lines 1-2) of patented claim 19;
- b) the claimed "*monitoring subscriber television viewing...*" (line 3) of current application claim 78 corresponds to the "*monitoring subscriber viewing activities...*" (lines 3-4) of patented claim 19;
- c) the claimed "*retrieving content characteristics...*" (lines 4-5) of current application claim 78 corresponds to "*retrieving source...includes description...*" (lines 5-8) of patented claim 19;

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- d) the claimed "*processing the subscriber television viewing interactions...*" (lines 6-7) of current application claim 78 corresponds to "*creating a first representation...*" (lines 9-11) of patented claim 19;
- e) the claimed "*retrieving heuristic rules...associate the subscriber television viewing habits with non-television viewing characteristics...*" (lines 8-10) of current application claim 78 corresponds to the "*retrieving a set of rules...the set of rules relates...subscriber viewing activities to at least one non-viewing parameter...*" (lines 12-18) of patented claim 19; and
- f) the claimed "*applying the heuristic rules...to generate the subscriber profile*" (lines 11-12) of current application claim 78 corresponds to the "*processing the subscriber viewing activities...and the set of rules to generate subscriber profile...*" (lines 19-23) of patented claim 19.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

The claimed subject matter of application claim 78 also corresponds to the subject matter of patented claim 23.

The claimed limitations of application claims 91 and 98 correspond to the limitations of patented claim 5.

The claimed limitations of dependent claims 79-90 (dependent on claim 78), claims 92-97 (dependent on claim 91) and claims 99-101 (dependent on claim 98) are obvious technical and television related features that describe or enhance the gathering, analyzing and processing procedures that occur in the monitoring of subscriber viewing habits and the generation of user profile.

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3. Claims 78-101 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46, 49, 50 and 52 of copending Application No. 09/205,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

The claimed limitations of application claims 78-79 correspond to the limitations of patented claim 46.

The claimed limitations of application claims 88 and 89 correspond to the limitations of patented claims 46 and 50 respectively.

The claimed limitations of application claims 91, 92 and 94 correspond to the limitations of patented claims 46, 49 and 49 respectively.

The limitations of application claim 98, 100 and 101 correspond to the limitations of patented claims 46, 46 and 50 respectively.

The claimed subject matter of application claim 98 corresponds to the subject matter of patented claim 52.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

The claimed limitations of dependent claims 80-87, 90 (dependent on claim 78), claims 92-93, 95-97 (dependent on claim 91) and claim 99 (dependent on claim 98) are obvious technical and television related features that describe or enhance the gathering, analyzing and processing procedures that occur in the monitoring of subscriber viewing habits and the generation of user profile.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

4. Applicant's arguments with respect to claims 78-101 have been considered but are moot in view of the new ground(s) of rejection.

Note to Applicant

5. The information disclosure statement (IDS) filed 12/08/2002 (paper #9) has been entered in the contents of the application file. However, the actual IDS letter, references and form 1449

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are not associated with the application. Applicant should re-submit the IDS letter, references and form 1449 for consideration on the merits.

Conclusion

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) ____ - ____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755. The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


Christopher Grant
Primary Examiner
Art Unit 2611

CG
March 7, 2003